

REMARKS

Claims 1-20 are pending, including independent claims 1, 14 and 18. Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Caro et al. '109 and further in view of Mullins '293. Claims 14-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eberhardt '932 in view of Caro et al. '109, and Mullins '293.

A. Rejection of Claims 1-13 under 35 U.S.C. § 103(a)

The obviousness rejection of prior claims 1-13 was premised on the assertion that the set of indicia 30 in figure 2A of Caro '109 corresponded to the player's entry into the instant win game "because they are used to play the game." Applicant does not acquiesce to this rejection. However, in order to expedite prosecution, Applicant has amended independent claims 1, 14, and 18 to make clear that the instant win game is conducted ***without use of the player's entry in the base game***. In other words, the instant win game is completely independent of and is in no way a function of the first set of game indicia. The second set of game indicia displays the outcome of the instant win game ***without reference to or comparison with the first set of game indicia***. This configuration is directly contrary to the game of Caro '109.

In Caro '109, Fig. 2a is a game ticket 12 that is printed and presented to the player after the player has wagered on the future lottery draw game and opted into the instant win game for an additional wager. There is no dispute that the numbers 26 are the player's entry for the future lottery draw game ***and the instant win game***, as clearly explained in Pars. 0042 through 0045. Par. 0049 clearly explains that, regardless of the outcome of the instant game, "the player continues to have the opportunity to play, and

possibly win, ***the future lottery game. With the same player-selected set of numbers***, play is therefore extended, and play value of the game increased.” In fact, Par. 0050 describes that, if the player turns in the ticket 12 to redeem the instant win game prize, a trailer ticket 14 may be issued to the player that includes information from the original ticket 12 necessary to play the future game:

In particular, ***the trailer includes the same player-selected first set 26 of game pieces as used in the instant lottery game.*** The trailer ticket can be like the original winning ticket [12], but without the second set 30 of the instant game.

There is thus no question that the player's selected numbers 26 ***are the same set of numbers used in play of the future lottery draw game.***

It is important to consider that the very purpose of the game of Caro '109 is to use the same entry in both games so as to allow the player to have "multiple play opportunities with his or her selected set of numbers." (Caro '109, paragraph 0022) Caro '109 expressly states that the purpose for using the same entry for both games is that:

With the same player-selected set of numbers, play is therefore extended, and play value of the game is increased. (Caro '109, paragraph 0049)

Respectfully, the present independent claims are directly contrary to the express function and purpose of Caro '109 in that they expressly dictate that the instant win game is conducted without use of the player's entry (first set of game indicia) in the base game. It is well settled that if a proposed modification in a Section 103 obviousness rejection would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no reasonable basis for the modification and the rejection is improper. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

With respect to the independent claims, Mullins was cited as teaching a lottery game wherein the theme of the instant win game is completely different from the theme of a base game. Mullins may teach to have games with different themes, but there is nothing in Mullins that would result in one skilled in the art ignoring the express intent of the game of Caro '109, as discussed above. With consideration of Mullins, one skilled in the art may modify Caro '109 to have different game themes, but not to directly contravene the purpose of Caro '109, which is to provide the player with different play opportunities ***with the same set of game indicia***.

Accordingly, applicant respectfully requests the Examiner to reconsider the obviousness rejection of independent claim 1 in view of the present amendment, and to allow the claim. Claims 2 through 13 only further patentably define the method of claim 1, and are allowable for at least the reasons claim 1 is allowable.

B. Rejection of Claims 14-20 under 35 U.S.C. § 103(a)

Independent claims 14 and 18 are amended herein to reflect the distinctions discussed above with respect to claim 1.

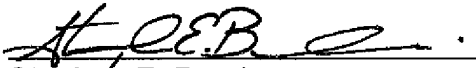
Claims 14-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eberhardt '932 in view of Caro et al. '109, and Mullins '293. Eberhardt '932 is relied upon in this rejection of the configuration of its gaming system. However, Eberhardt '932 fails to correct the deficiencies discussed above with respect to the base combination of Caro et al. '109 and Mullins '293. Accordingly, claims 14 through 20 are allowable for at least the reasons discussed above with respect to claims 1 through 13.

With the present Amendment, applicant respectfully submits that all pending claims are allowable, and that the application is in condition for allowance. Favorable

action thereon is respectfully requested. The Examiner is encouraged to contact the undersigned at his convenience should he have any questions regarding this matter or require any additional information. Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully submitted,

DORITY & MANNING, P.A.

By: 
Stephen E. Bondura
Registration No.: 35,070

P.O. Box 1449
Greenville, SC 29602-1449
(864) 271-1592
Fax (864) 233-7342